

REMARKS

The Final Office Action mailed February 7, 2008 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendment of the Claims

Claims 1-15 and 20-36 are currently pending.

No claims stand allowed.

Claims 16-19 were previously cancelled without prejudice or disclaimer of the subject matter contained therein.

Claims 1, 20, 35, and 36 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification, figures, and claims as originally filed. No “new matter” has been added by the Amendment.

With this Amendment it is respectfully submitted the claims satisfy the statutory requirements.

The First 35 U.S.C. § 103 Rejection

Claims 1-15, 20-36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Microsoft.^{1 2} This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

¹ Microsoft White Paper, “Understanding Patch and Update Management: Microsoft’s Software Update Strategy,” Microsoft Corporation, October 2003, pp. i-iii, 1-14.

² Office Action mailed February 7, 2008, at ¶ 3.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.³

Claim 1

Claim 1 as presently amended recites:

A method for automatically distributing a software update to a network of devices of a peer-to-peer network controlled by an organization, the method comprising:
 receiving application and system information from one or more inoculation clients installed on the devices, the receiving performed via peer-to-peer communication;
 comparing the application and system information with application and version information in a global update repository to determine if an update exists for a corresponding application controlled by an inoculation client, the global update repository including updates from multiple application manufacturers;
 queuing the update if an update exists for an application controlled by an inoculation client;
 receiving a communication from the corresponding inoculation client checking for available distribution jobs; and
 automatically transmitting the update to the corresponding inoculation client in response to the receiving a communication if an update exists for an application controlled by the corresponding inoculation client.

The Examiner states:

... Microsoft discloses,
 A method for automatically distributing a software update to a network of devices controlled by an organization, the method comprising:
 receiving application and system information from one or more inoculation clients installed on the devices, said receiving performed via peer-to-peer communication,, (See the whole reference, particularly, Microsoft provides tools to a client within a small Organizations (p.7), Medium-Sized Organizations (p. 9), Large Organizations (p. 11), etc., these organizations are inoculation client application and system information peer-to-peer receiver);
 comparing said application and system information with application and version information in a global update repository to determine if an update exists for a

³ M.P.E.P § 2143.

corresponding application controlled by an inoculation client; the global update repository including updates from multiple application manufacturers, (For example, see, p. 7, p. 10, Microsoft Baseline Security Analyzer supports security update that has means for comparing application and system information with the application and version information in an update repository. The analyzer supports for performing the security updates portion of a scan. Also see p 11, Microsoft Download website ('update repository'). See p. 13, "Microsoft Update", scheduled for release in Spring 2004, will consolidate the patches and updates into one repository ('update repository'). At launch, Microsoft Update will support patches, updates, and service packs for Windows 2000, XP, Server 2000 & 2003 operating systems as well as Microsoft Office 2003, Microsoft SQL Server 2000, and Microsoft Exchange Server 2003); queueing the update if an update exists for an application controlled by an inoculation client; receiving a communication from the corresponding inoculation client checking for available distribution jobs; (For example, the baseline security Analyzer allows users to scan (queue) one or more Windows-based computers for common security misconfigurations (p. 7-8) (i.e. has means for checking for available distribution jobs - also has means for comparing said application and system information), Security Update Inventory Tool provides ongoing scans of client computers for installed or applicable security updates (p. 11), Microsoft Baseline Security Analyzer 2.0 provides a true enterprise-ready scanning technology (p. 13). See content within Microsoft Baseline Security Analyzer 2.0 (p.13)); and automatically transmitting the update to the corresponding inoculation client in response to the receiving a communication if an update exists for an application controlled by the corresponding inoculation client (For example, see Distribute Software Updates Wizard Installer (p. 11-12) and see Office Update Inventory Tool).

Microsoft does not explicitly mention GLOBAL UPDATE REPOSITORY, but its website Microsoft Download website ('update repository') and in p. 13, "Microsoft Update", it mentions a future consolidation of a centralized update database. Thus, it is obvious to the ordinarily in the art that, GLOBAL UPDATE REPOSITORY is only business manner complying the law or business license. It conforms to business agreements rather than an invention feature. For example, in p. 13, Microsoft clearly addresses that it can provide centralized server, and thus with a centralized server it can provide and update patching globally.⁴

The Applicant respectfully disagrees for the reasons set forth below.

Microsoft Does Not Disclose Receiving Application And System Information From One Or More Inoculation Clients Installed On The Devices, The Receiving Performed Via Peer-To-Peer Communication

⁴ Final Office Action dated February 7, 2008, pp. 4-5.

Contrary to the Examiner's statement, Microsoft does not disclose receiving application and system information from one or more inoculation clients installed on the devices, the receiving performed via peer-to-peer communication as required by Claim 1. In support of the Examiner's statement, the Examiner refers to pages 7, 9, and 11 of Microsoft, which speak generally about patch and update management in small-, medium-, and large-sized organizations, but say nothing about receiving the application and system information via peer-to-peer communication.

In response, the Examiner states:

... It is unclear what point in this argument, whether the argument is that Microsoft does not teach receiving application information from the clients or Microsoft does not teach peer-to-peer. Applicants' argument does not directly to the main functionality of the claims, but is off from the heart of the specification. It should be noted that the heart of the specification is to disclose patch management as Microsoft does. It should be noted that Internet provides two-way communication, where a clients within Microsoft can transparently use the Microsoft websites, as shown in p. 6 and p. 7, and p. 14, for providing the information. In p. 7, "Windows Update", it is for a client who communicates with its server for receiving patch update. With a baseline security Analyzer, it allows users to scan (queue) one or more Windows based computers for common security misconfigurations (p. 7-8). This is two-way communications. On the other hand, a peer-to-peer system according to the Microsoft dictionary is only a network of two or more computers that use the same program or type of program to communicate and share the data. Each computer acts like a server to other in the network. Thus, the inclusion of the peer-to-peer in a claim does not make it distinct from a pair of server/client computers, or a cluster of computers communicated in an organization like of Microsoft. Therefore, Microsoft discloses the claimed limitation above.⁵

The Applicant respectfully submits the Examiner's reference to "the heart of the specification" evidences an impermissible attempt to ignore limitations found in the claim. The Examiner has used one reference (Microsoft) of two references in a rejection under 35 U.S.C. § 103 to allegedly read on the claim limitation "receiving application and system information from one or

⁵ Office Action at ¶ 2.

more inoculation clients installed on the devices, the receiving performed via peer-to-peer communication.” The Examiner’s statement “[i]t is unclear ... whether the argument is that Microsoft does not teach receiving application information from the clients or Microsoft does not teach peer-to-peer” impermissibly paraphrases limitations found in Claim 1 into two seemingly unrelated limitations. The Applicant respectfully submits the cited references do not teach or suggest what is *claimed* in Claim 1, e.g. “receiving application and system information from one or more inoculation clients installed on the devices, the receiving performed via peer-to-peer communication.”

Furthermore, the Examiner’s statement “a peer-to-peer system according to the Microsoft dictionary is only a network of two or more computers that use the same program or type of program to communicate and share the data. Each computer acts like a server to other in the network. Thus, the inclusion of the peer-to-peer in a claim does not make it distinct from a pair of server/client computers, or a cluster of computers communicated in an organization like of Microsoft” is contrary to what is understood by those skilled in the art. The Examiner’s statement refers to “the Microsoft dictionary.” It is unclear exactly what publication the Examiner intends to refer, since the Examiner has not provided a complete citation for this reference. The Applicant assumes the Examiner intends to refer to the publication *Microsoft Computer Dictionary*, Fifth Edition, Microsoft, © 2002. The *Microsoft Computer Dictionary* reference defines term “peer-to-peer architecture” as follows:

peer-to-peer architecture *n.* A network of two or more computers that use the same program or type of program to communicate and share data. Each computer, or *peer*, is considered equal in terms of responsibilities and each acts as a server to the others in the network. Unlike a client/server architecture, a dedicated file server is not required. However, network performance is generally not as good as under client/server, especially under heavy loads. *Also called:* peer-to-peer network. *See also* peer, peer-to-peer communications, server. *Compare* client/server architecture.⁶

⁶ “Microsoft Computer Dictionary, Fifth Edition,” Microsoft, © 2002, p. 397. (emphasis in original)

The Examiner has agreed that Microsoft discloses a client/server architecture. And as can be seen by the above definition of peer-to-peer architecture cited by the Examiner, a client/server architecture (like disclosed in Microsoft) is clearly differentiated from a peer-to-peer architecture. With this Amendment, Claim 1 has been amended to make this distinction more clear. Thus, the inclusion of “peer-to-peer” in the claim *does* make it distinct. For the above reasons, the 35 U.S.C. § 103 Rejection of Claim 1 based on Microsoft is unsupported by the cited art of record. Thus, a *prima facie* case has not been established and the rejection must be withdrawn.

Microsoft Does Not Disclose Comparing Application And System Information With Application And Version Information In A Global Update Repository To Determine If An Update Exists For A Corresponding Application Controlled By An Inoculation Client, The Global Update Repository Including Updates From Multiple Application Manufacturers

Contrary to the Examiner’s statement, Microsoft does not disclose comparing said application and system information with application and version information in a global update repository to determine if an update exists for a corresponding application controlled by an inoculation client, the global update repository including updates from multiple application manufacturers as required by Claim 1. In support of the Examiner’s statement, the Examiner refers to portions of Microsoft that speak generally about updates from a single application manufacturer (Microsoft). But nowhere does Microsoft disclose a global update repository that includes updates from *multiple* application manufacturers as required by Claim 1.

Furthermore, the following Examiner’s statement is nonsensical:

Microsoft does not explicitly mention GLOBAL UPDATE REPOSITORY, but its website Microsoft Download website (‘update repository’) and in p. 13, “Microsoft Update”, it mentions a future consolidation of a centralized update database.

Thus, it is obvious to the ordinarily in the art that, GLOBAL UPDATE REPOSITORY is only business manner complying the law or business license. It conforms to business agreements rather than an invention feature. For example, in p. 13, Microsoft clearly addresses that it can provide centralized server, and thus with a centralized server it can provide and update patching globally.⁷

The Examiner admits that Microsoft does not teach a global update repository that includes updates from multiple application manufacturers, but does not provide a specific reference where such a limitation is found, instead arguing the claimed limitation “is only business manner complying the law or business license.” Therefore, the Applicants assume that the Examiner intended to take official notice of facts under M.P.E.P. § 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or “well-known” prior art. Under M.P.E.P. § 2144.03, “[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.” The Applicants hereby traverse the assertion and requests that a reference be cited in support of the position outlined in the Office Action.

Additionally, the Examiner’s statement “[t]hus, it is obvious to the ordinarily in the art that, GLOBAL UPDATE REPOSITORY is only business manner complying the law or business license”⁸ indicates the Examiner’s conclusion of obviousness is based on improper hindsight reasoning. In more detail, the Examiner’s use of the verb “is,” which is the present tense form of the verb “to be” indicates the Examiner’s conclusion of obviousness is based upon knowledge as of the date of the Office Action, which is after the time the claimed invention was made.

According to established caselaw,

[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention

⁷ Office Action dated June 20, 2007, pp. 4-5.

⁸ Office Action at p. 5. (emphasis added)

was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper."⁹

As the Examiner's statement failed to take into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made, the Examiner's conclusion of obviousness is based improperly on improper hindsight reasoning.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the Applicant's argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.¹⁰

The Examiner also states:

In the claims, for example Claim 1, Applicants alleged that Microsoft does not teach the global update repository. However, as mentioned in the previous action, global is only relative term. Centralized database for update is not new, and it is used because the business purpose rather patentability purpose. For example, Microsoft could provide global update, i.e. all internet users can receive patch update by connecting to the Microsoft central server or using the Microsoft web site. Evidence is they mention it in p. 13. It should be noted that license requirement will not allows a company to open an update to all Internet users. Therefore, when includes GUR in the claims, it does not present a patentability, but rather preempts a business manner. Business corporations such as SUN Micros System, IBM, Microsoft own centralized server, they can provide global update.¹¹

First, the Applicants did not allege Microsoft does not teach a global update repository; the Applicants submit Microsoft does not teach the global update repository including updates from multiple application manufacturers, as required by Claim 1. Second, the Applicants respectfully

⁹ *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (emphasis added); see also M.P.E.P. § 2145, part X.A.

submit that the Examiner's reference to what Microsoft *could* do, and what particular business corporations *can* provide amounts to mere speculation not supported by the cited art of record. The Examiner also points to page 13 of Microsoft. However, page 13 of Microsoft includes a discussion of various Microsoft products but says nothing about the claimed limitation of a global update repository including updates from multiple application manufacturers.

The Examiner also states:

It appears the argument is that "GLOBAL UPDATE REPOSITORY" is invention. Examiner disagrees. Microsoft reference does show it distributes patch update to a network device controlled by an organization such as a Government Agency, or all Microsoft' clients etc. Microsoft also has inoculation clients. The patch distribution is the same as of the claims. However, Microsoft does not use the term "GLOBAL UPDATE REPOSITORY"; however, "GLOBAL UPDATE REPOSITORY" is equivalent to a centralized database, and centralized database is common in the art, and its size is dependent on the business boundary. Therefore, Examiner finds that 103 issue is appropriate to address the Applicants' argument.¹²

Again, the present application includes multiple embodiments of the present invention, and claims directed to several of those embodiments. The Examiner's narrow focus on "global update repository" improperly ignores other claimed limitations not taught or suggested by the cited art of record as discussed previously.

Furthermore, the Applicants submit the Examiner has failed to consider the claimed invention as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been

¹⁰ *In re Herrmann*, 261 F.2d 598 (CCPA 1958) (The court noted that since applicant's arguments were not questioned by the examiner, the court was constrained to accept the arguments at face value and thus held the claims to be allowable); *See In re Soni*, 54 F.3d 746 (Fed. Cir. 1995).

¹¹ Office Action mailed June 20, 2007, at ¶ 3.

¹² Office Action at ¶ 3.

obvious, but whether the claimed invention as a whole would have been obvious.¹³ The Examiner states that “It appears the argument is that “GLOBAL UPDATE REPOSITORY” is invention.”¹⁴ However, Claim 1 requires the global update repository including updates from multiple application manufacturers. (emphasis added) By distilling the claimed limitation of “global update repository including updates from multiple application manufacturers” down to “global update repository,” the Examiner has disregarded the requirement of analyzing the subject matter “as a whole.”¹⁵ For this additional reason, the 35 U.S.C. § 103 rejection of Claim 25 based on Microsoft is unsupported by the art.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the Applicant’s argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant’s arguments and that the Claims are allowable.¹⁶

For the above reasons, the 35 U.S.C. § 103 Rejection of Claim 1 based on Microsoft is unsupported by the cited art of record. Thus, a *prima facie* case has not been established and the rejection must be withdrawn.

¹³ M.P.E.P. § 2141.02, part I. (emphasis in original) *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

¹⁴ Office Action at p. 3.

¹⁵ See M.P.E.P. § 2142.02, part II. See also *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to a 10% per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed); *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) (District court focused on the “concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material,” but “disregarded express limitations that the product be an ophthalmic lens formed of a transparent cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer.”). See also *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) (“treating the advantage as the invention disregards statutory requirement that the invention be viewed ‘as a whole’”); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

Claims 2-15

Claims 2-15 depend from Claim 1. Claim 1 being allowable, Claims 2-15 must also be allowable.

Claim 9

Claim 9 recites:

The method of claim 8, therein the global update repository mines, retrieves, and archives external update information.

The Examiner states:

... Microsoft discloses, The method of claim 8, therein said global update repository mines, retrieves, and archives external update information (i.e. Microsoft /Microsoft downloads Web site; or see "consolidate the patches and updates into one repository" (p. 13)).¹⁷

The Applicants respectfully disagree. Contrary to the Examiner's statement, Microsoft does not disclose that the global update repository mines, retrieves, and archives external update information as required by Claim 9. In support of the Examiner's statement, the Examiner refers to page 13 of Microsoft, which speaks generally about consolidating Microsoft patches and updates into one repository, but says nothing about the required claim limitation. The cited portion of Microsoft does not indicate that it is the global update repository that performs the "consolidating" to which the Examiner refers. Furthermore, the Applicants respectfully submit that the Examiner's attempt to equate the "consolidate" of Microsoft with "mines, retrieves, and archives" required by Claim 9, is improper. For this additional reason, the 35 U.S.C. § 103 Rejection of Claim 9 is unsupported by the cited art of record and must be withdrawn.

¹⁶ *In re Herrmann, supra.*

¹⁷ Office Action at p. 6.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the Applicant's argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.¹⁸

Claim 10

Claim 10 recites:

The method of claim 9, wherein the external update information is mined and retrieved from external security websites.

The Examiner states:

... Microsoft discloses, The method of claim 9, wherein said external update information is mined and retrieved from external security websites (.e. Microsoft/Microsoft downloads Web site; or see "consolidate the patches and updates into one repository" (p. 13)).¹⁹

The Applicants respectfully disagree. As Claim 10 depends from Claim 9, the arguments made above with respect to Claim 9 apply here as well.

Contrary to the Examiner's statement, Microsoft does not disclose wherein the external update information is mined and retrieved from external security websites as required by Claim 10. In support of the Examiner's statement, the Examiner refers to page 13 of Microsoft, which says nothing about external security websites, let alone mining and retrieving external update information from the external security websites. For this additional reason, the 35 U.S.C. § 103 Rejection of Claim 10 is unsupported by the cited art of record and must be withdrawn.

¹⁸ *In re Herrmann, supra.*

¹⁹ Office Action at p. 7.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the Applicant's argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.²⁰

Claim 11

Claim 11 recites:

The method of claim 10, wherein the global update repository uses web spiders.

The Examiner states:

... Microsoft discloses, The method of claim 10, wherein said global update repository uses web spiders (i.e. Microsoft/Microsoft downloads Web site; or see "consolidate the patches and updates into one repository" (p. 13)).²¹

The Applicants respectfully disagree. As Claim 11 depends from Claim 10, the arguments made above with respect to Claim 10 apply here as well.

Contrary to the Examiner's statement, Microsoft does not disclose wherein the global update repository uses web spiders as required by Claim 11. In support of the Examiner's statement, the Examiner refers to page 13 of Microsoft, which speaks generally about xx but says nothing about web spiders, let alone use of web spiders by the global update repository. For this additional reason, the 35 U.S.C. § 103 Rejection of Claim 11 is unsupported by the cited art of record and must be withdrawn.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the

²⁰ *In re Herrmann, supra.*

²¹ Office Action at p. 7.

Applicant's argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.²²

Claim 12

Claim 12 recites:

The method of claim 1, wherein the comparing includes utilizing an HTTP GET or POST command.

The Examiner states:

... Microsoft discloses, The method of claim 1, wherein said comparing includes utilizing an HTTP GET or POST command. (Functional equivalence: "command line operations for scanning one or more Windows-based computers" (p. 8); "MBSA UI or in the MBSA command line interface, seen in p. 7")²³

The Applicants respectfully disagree. Contrary to the Examiner's statement, Microsoft does not disclose wherein the comparing includes utilizing an HTTP GET or POST command as required by Claim 12. In support of the Examiner's statement, the Examiner refers to page 7 of Microsoft, which speaks generally about a command line interface for scanning Windows-based computers, but says nothing about the required claim limitation. The Applicants respectfully submit the Examiner's attempt to equate utilizing an HTTP GET or POST command with command line operations is improper.

In response, the Examiner states:

With regard to the Applicants arguing the GET and POST commands. It should be noted that GET/ADD/DELETE/POST commands are public use and standardized for sending request and response between two computers connected in a network via Browser using HTTP protocol. Microsoft users use this standard protocol. See this standard POST and GET commands in The Network Working Group which defines the specification to address these standard commands for network

²² *In re Hermann, supra.*

²³ Office Action at p. 7.

communication. It is improper to address common and standard features used in publics as a claimed feature, where with own.²⁴

The Applicant reminds the Examiner that Claim 12 depends from Claim 1, and that Claim 12 further defines the “comparing” element of Claim 1. As such, the Examiner’s statement that “[i]t is improper to address common and standard features used in publics as a claimed feature, where with own” is misplaced. The Examiner’s rejection of Claim 12 merely points to a user interface in Microsoft, and makes the conclusory statement that “Microsoft users uses this standard protocol.” The Examiner provides no citation to support this assertion. The Applicant respectfully requests the Examiner provide a citation in support of the assertion.

For this additional reason, the 35 U.S.C. § 103 Rejection of Claim 12 is unsupported by the cited art of record and must be withdrawn.

Claim 13

Claim 13 recites:

The method of claim 9, wherein the external update information contains a vendor type, the vendor type being automatic download and release, automatic download and manually confirm release, or manually download and confirm.

The Examiner states:

... Microsoft discloses, The method of claim 9, wherein said external update information contains a vendor type, said vendor type being automatic download and release, automatic download and manually confirm release, or manually download and confirm (See section Software Update Service 2.0, p. 13).²⁵

²⁴ Office Action at p. 3.

²⁵ Office Action at p. 7.

The Applicants respectfully disagree. Contrary to the Examiner's statement, Microsoft does not disclose wherein the external update information contains a vendor type, the vendor type being automatic download and release, automatic download and manually confirm release, or manually download and confirm, as required by Claim 13. In support of the Examiner's statement, the Examiner refers to the following portion of Microsoft:

Software Update Service 2.0

Building upon the strengths of SUS 1.0, the next version will increase administrative flexibility while simplifying overall patch and update management. SUS 2.0 should be available by Spring 2004 and will include numerous improvements and enhancements.

The initial release of SUS 2.0 will include support the patches available on Microsoft Update, (mentioned above). By the end of 2004, Microsoft plans to include support for all applications on Microsoft Update, (with the possible exception of MSN and Xbox). Further improvements include: an enhanced reporting environment per machine, per group, or per update information detail; and download and install success or failure reports with error detail.

SUS 2.0 will support system rollbacks to previous configurations if an installed update causes undesirable results. Also, updates may be targeted to specific machine groups through Active Directory Group Policy or static list-based non-Active Directory definitions.²⁶

The cited portion of Microsoft says nothing about a vendor type, let alone that the values of such a vendor type are automatic download and release, automatic download and manually confirm release, or manually download and confirm as required by Claim 13. For this additional reason, the 35 U.S.C. § 103 Rejection of Claim 13 is unsupported by the cited art of record and must be withdrawn.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the

²⁶ Microsoft, Software Update Service 2.0, p. 13

Applicant's argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.²⁷

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Claims 35 and 36

Claim 35 is an *In re Beauregard* claim corresponding to method claim 1. Claim 36 is a non-means-plus-function apparatus claim corresponding to method claim 1. Claim 1 being allowable, Claims 35 and 36 must also be allowable for at least the same reasons as Claim 1.

Claims 20-34

Claims 20-34 are means-plus-function claims. In support of the 35 U.S.C. § 103 rejection of Claims 20-34 based on Microsoft, the Examiner refers to substantially the same portions of Microsoft used in the rejection of method claims 1-15. The Examiner is referred to the U.S. Patent and Trademark Office document entitled "Examination Guidelines For Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C § 112, 6th Paragraph" ("Guidelines"), a copy of which is submitted herewith for the Examiner's convenience. The Guidelines state:

... Per our holding, the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, *the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a Patentability determination* ...

... [The] examiner shall interpret a § 112, 6th paragraph "means or step plus function" limitation in a claim as limited to the corresponding structure, materials

²⁷ *In re Herrmann, supra.*

or acts described in the specification and equivalents thereof in acts accordance with the following guidelines.²⁸

The Guidelines state further:

... if a prior art reference teaches identity of function to that specified in a claim, then under Donaldson an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.²⁹

As Claims 20-34 of the present application are means-plus-function claims and Claims 1-15 of the instant application are non-means-plus-function claims, they cannot be said to be drawn to identical subject matter. Furthermore, the Examiner has not shown for each means-plus-function claim, that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function. Therefore, the Examiner has not established a *prima facie* case and the 35 U.S.C. § 103 rejection of Claims 20-34 must be withdrawn.

Additionally, the Applicants made the above argument in the Response mailed November 20, 2007. Considering that the Examiner has not provided any comments or rebuttal to the Applicant's argument, but only restated prior rejections, it can be assumed that the Examiner agrees to the Applicant's arguments and that the Claims are allowable.³⁰

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

²⁸ "Examination Guidelines For Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C § 112, 6th Paragraph," U.S. Patent and Trademark Office, <http://www.uspto.gov/web/offices/pac/dapp/pdf/exmgu.pdf>, p. 1. (emphasis added)

²⁹ Guidelines at p. 3. (emphasis in original)

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID BROWN
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Dated: July 7, 2008

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³⁰ *In re Herrmann, supra.*